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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/263,689 03/05/99 NI

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STERNE KESSLER GOLDSTEIN & FOX  
1100 NEW YORK AVENUE N W  
SUITE 600  
WASHINGTON DC 20005-3934

EXAMINER

CANELLA, K

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

11  
10/25/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/263,689

Applicant(s)

NI et al

Examiner

Karen Canella

Group Art Unit  
1642



- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 days month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

- ☒ Claim(s) 24-27, 62-70, 77-80, and 90-127 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claims 24-27, 62-70, 77-80, and 90-127 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

1. Please note that the examiner to which your application has been assigned at the PTO has changed.
2. Claims 17-23, 28-61, 71-76 and 81-89 have been canceled. Claim 70 has been amended. Claims 24-27, 62-70, 77-80, 90-127 are pending.

***Election/Restriction***

3. Upon further review and reconsideration, and in light of applicants arguments set forth in Paper No. 10, the restriction requirement of Paper No. 8 is vacated. The following restriction will apply:

I. Claims 62-67 and 90-127, drawn to a polypeptides of SEQ ID NO:4, isolated proteins encoded by polynucleotides which hybridize to SEQ ID NO:3 and a method of producing the polypeptide of SEQ ID NO:4, classified in class 514, subclass 2 and class 435, subclass 69.1.

II. Claims 24 and 68, drawn to antibodies which bind to the polypeptides of SEQ ID NO: 4 and antibodies which bind to the polypeptides encoded by polynucleotides which hybridize to SEQ ID NO:3, classified in class 424, subclass 130.1.

III. Claims 25 and 69, drawn to a method of detecting the polypeptides of SEQ ID NO:4 and polypeptides encoded by polynucleotides which hybridize to SEQ ID NO:3, classified in class 435, subclass 4.

IV. Claims 26 and 27, drawn to a method of treatment comprising the administration of the polypeptide of SEQ ID NO:4, classified in class 530, subclass 387.1.

V. Claim 70, drawn to a polypeptide of SEQ ID NO:8, classified in class 514, subclass 2.

VI. Claim 77, drawn to an antibody which binds the polypeptide of SEQ ID NO:8, classified in class 424, subclass 130.1.

VII. Claim 79 and 80 drawn to a method of treatment comprising the administration of the polypeptide of SEQ ID NO:8, classified in class 530, subclass 350.

VIII. Claim 78 drawn to a method for detecting the polypeptide of SEQ ID NO:8, classified in class 435, subclass 4.

Inventions of Groups I, II, V and VI are structurally and functionally different products which are made by different methods and have different uses. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

The methods of Groups III, IV, VII and VIII differ in the method objectives, method steps and parameters and in reagents used.

Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide of Group I can be used to raise the antibody to SEQ ID NO:4.

Inventions V and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide of Group V can be used to raise the antibody to SEQ ID NO:8.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Group II can be used to raise an anti-idiotypic antibody.

Inventions VI and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Group VI can be used to raise an anti-idiotypic antibody.


4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Canella, Ph.D.  
Patent Examiner, Group 1642  
October 20, 2000

  
GEETHA P. BANSAL  
PRIMARY EXAMINER